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Re: U.S. Patent Application No. 10/821,263

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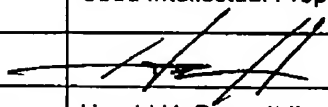
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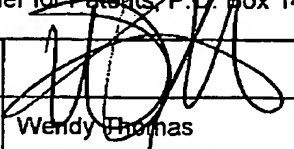
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<b>TRANSMITTAL FORM</b> <i>(To be used for all correspondence after initial filing)</i>	Application Number	10/821,263
	Filing Date	April 8, 2004
	First Named Inventor	Simone Sassolini
	Art Unit	2823
	Examiner Name	George R. Fourson III
	Attorney Docket No.	854063.748

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement and Transmittal <input type="checkbox"/> Cited References <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 <input type="checkbox"/> Response to Missing Parts/Incomplete Application	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Request for Corrected Filing Receipt <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation, Change of Correspondence Address <input type="checkbox"/> Declaration <input type="checkbox"/> Statement under 37 CFR 3.73(b) <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC ( <i>Appeal Notice, Brief, Reply Brief</i> ) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Return Receipt Postcard <input checked="" type="checkbox"/> Other Enclosure(s) ( <i>please identify below</i> ): Facsimile Cover Sheet _____ _____ _____ _____
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May 30, 2006

Date

Wendy Thomas

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Simone Sassolini et al.  
Application No. : 10/821,263  
Filed : April 8, 2004  
For : METHOD FOR MANUFACTURING A MICRO-ELECTRO-MECHANICAL DEVICE, IN PARTICULAR AN OPTICAL MICROSWITCH, AND MICRO-ELECTRO-MECHANICAL DEVICE THUS OBTAINED

Examiner : George R. Fourson III  
Art Unit : 2823  
Docket No. : 854063.748  
Date : May 30, 2006

Mail Stop Petition  
Commissioner for Patents  
2900 Crystal Drive  
Arlington, VA 22202-3513

PETITION FROM REQUIREMENT OF RESTRICTION UNDER 37 CFR 1.144

Commissioner for Patents:

Petitioner hereby petitions the Director to review the Restriction Requirement issued in the present case on September 14, 2005.

In response to the above referenced requirement, Petitioner submitted an election with traverse on February 28, 2006, in which reconsideration was requested, as required under 37 CFR 1.181, and following which the restriction was made final in an Office Action dated April 28, 2006.

In the Restriction Requirement, the claims were restricted to three patentably distinct species. With respect to the first and second species, the Examiner cited elements of claims 1 and 14, respectively, to demonstrate mutual exclusivity of the species.

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In Petitioner's response, reference was made to the detailed description of the specification, in which all of the limitations of both claims 1 and 14 are disclosed with reference to a single embodiment, and are thus not mutually exclusive.

In making the restriction final, the Examiner did not address the Petitioner's argument except to state that the claims recite mutually exclusive characteristics that render the claims separately patentable.

The MPEP provides a definition of the term *mutually exclusive*, as it pertains to restriction practice: "Claims to different species are mutually exclusive if one claim recites limitations *disclosed* for a first species but not a second, while a second claim recites limitations *disclosed* only for the second species and not the first." (MPEP § 806.04(f), emphasis added.) Thus, if a disclosed embodiment includes all the limitations of each of two claims, these claims are not mutually exclusive, and are not subject to restriction on that basis.

In the specification, an embodiment is described, with reference to Figures 1-21, in which a detailed description of a manufacturing process is provided, beginning at page 6, line 2, and extending generally through page 12, line 13. In the discussion that follows, reference will be made to this detailed description in the specification and figures. Each of the elements of claims 1 and 14 will be shown to read on the figures and description of the *same* embodiment. MPEP § 806.04(e) states that "Claims are definitions of inventions. *Claims are never species. ... Species are always the specifically different embodiments.*" (Emphasis in original.) Thus, on the one hand, it is appropriate to provide claims of varying scope though directed to a common embodiment, while, on the other hand, a single embodiment should not be subject to a restriction to more than one species.

Figures 1-11 of the specification illustrate process steps for preparing a first wafer, which include various deposition, masking and etching steps, etc. A second wafer is described with reference to Figure 12, while the remaining figures accompany a description of a bonding step and the steps carried out on the resulting composite wafer.

Claim 1 recites, "providing a first semiconductor wafer, having a first layer of semiconductor material, and a second layer of semiconductor material, arranged on said first layer." Claim 14 recites, "defining, in a first semiconductor substrate, a plurality of anchor regions." Figure 1 shows a wafer 2 as claimed in claim 1, that includes a semiconductor

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substrate 1, as claimed in claim 14, and on which the first layer recited in claim 1 can be read. The anchor regions of claim 14 can be read on the anchor regions that are formed in the trenches 6 also shown in Figure 1. These features are described in the specification beginning at line 2 of page 6, particularly at lines 2, 3, 7, 8, 13, and 14.

The second layer of claim 1 may be read on the polysilicon layer 16, described at line 27 of page 6 with reference to Figure 7.

Figure 13 shows wafers 2 and 32 immediately following a bonding step in which the wafers are bonded together to form composite wafer 40. Claim 1 recites, "bonding said first wafer to a second wafer, with said second layer facing said second wafer," while claim 14 recites, "bonding a second semiconductor substrate to the first substrate." The wafer 2 and a second wafer 32 are shown in Figure 13, as recited in claim 1, with the second layer 16 (shown at 17 in Figure 13) of the first wafer facing the second wafer. The first wafer 2 comprises a first semiconductor substrate 1, while the second wafer 32 comprises a second semiconductor substrate 33, as recited in claim 14. This process step is described on page 8, lines 14-27.

Figure 17 shows the upper surface of the composite wafer formed by the bonding step. The upper surface comprises the first semiconductor substrate 1, which was the first layer of the first wafer 2. Figure 18 is a cross-sectional view of the structure shown in Figure 17, and shows the relationship of various layers. Claim 1 recites, "forming, after the bonding step, second supporting parts and second operative parts of said device in said first layer." Claim 14 recites, "forming, after the bonding and defining steps, a rotor region in the first semiconductor substrate such that the anchor regions remain between the rotor region and an outer region of the first substrate." The second supporting parts and second operative parts of claim 1 may be read respectively on the supporting frames 47, 48, and rotating assemblies 51-54 of Figures 17 and 18. The rotor region and outer region of claim 14 may be read on the moving inner frame 48 and the fixed external supporting frame 47, respectively, of Figures 17 and 18, while the anchor regions 9 are clearly shown between the external frame 47 and the inner frame 48 in figure 17. Features shown in Figures 17 and 18 are described in the specification beginning at page 9, line 22.

The only remaining limitation of claim 1 recites, "forming first supporting parts and first operative parts in said second layer." These elements may be read on the first external supporting frame 17, and stator electrodes 20-23, respectively, of Figure 18. Formation of these

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elements from the second layer 16 is described with reference to Figures 8 and 9 beginning at page 7, line 10.

The remaining limitation of claim 14 recites, "removing the anchor regions such that the rotor region is free to move with respect to the outer region and the second substrate." This step is referred to in the description of Figure 17 on page 10, lines 5-10, and is described in more detail on page 11, particularly at lines 9 and 21-24.

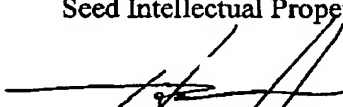
Clearly, claims 1 and 14 can each be read on the same embodiment. Thus, these claims 1 and 14 are not mutually exclusive, and therefore should not be separately restricted.

In view of the above discussion, Petitioner respectfully requests that the U.S. Patent and Trademark Office withdraw the restriction between the first and second species and examine claim 14 on its merits.

The correlation of features of the specification to the elements of the claims is not intended to limit the scope of the claims to the features indicated, or even to features disclosed in the specification, but merely to demonstrate that both claims may be read on features of a single embodiment, and thus a single species. Various elements of the claims may also be read on other disclosed features or embodiments, or on other embodiments not disclosed in the present application.

Respectfully submitted,

Seed Intellectual Property Law Group PLLC

  
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